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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.   | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 10/615,320      | 07/07/2003  | Rudolf H. Aebersold  | 66661-055 (P-IS 5661) | 9356             |

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EXAMINER

CEPERLEY, MARY

ART UNIT PAPER NUMBER

1641

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/615,320

Applicant(s)

AEBERSOLD ET AL.

Examiner

Mary (Molly) E. Ceperley

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-105 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

Art Unit: 1641

**1)** Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. \*\* Claims 1-75, drawn to methods of labeling a molecule and analyzing a molecule, classified in class 530.
- II. \*\* Claims 76-105, drawn to solid support-based compositions, classified in class 436.

**\*\*Note:** Each of Inventions I and II is drawn to multiple patentably distinct inventions, each invention being defined by the specific type of "chemical group". Each separate and distinct invention is defined as the combination of a specific "cleavable functional group", a specific "functional group" AND a specific "reactive group" AND a defined structure which indicates how these three variables are positioned relative to each other (i.e. these specifics constitute a distinct "chemical group"). Upon election of either of Inventions I or II, applicants are required to further elect a single combination of the variables defined above to define a "chemical group"; this election will determine the specific invention (not an election of species) which is to be examined. The claims will then be examined on the merits to the extent that they encompass the elected invention. The methods of use ~~or~~ compositions *per se* (based on the election of either Invention I or Invention II) will further be examined to the extent that they encompass species which are not patentably distinct from the elected "chemical group".

**2)** The inventions are distinct, each from the other because of the following reasons:

**a)** Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the method of Invention I does not require the use of a "solid support" as defined in claim 76 which requires a "tag" and a specific spatial arrangement of the "cleavable functional group", "tag", and

"reactive group covalently linked to a sample molecule". Further, the composition of Invention II would not be useful in the method of Invention I since the method of Invention I requires that the sample be contacted with a solid support while the composition of Invention II already has the sample covalently linked to the reactive group.

**b)** The different inventions described in the "**Note**" above are distinct for the reason that different types of "cleavable functional groups", "functional groups" and "reactive groups" provide different modes of operation. For example, a photo-cleavable group and an enzyme-cleavable group would be expected to be very different from each other in terms of chemical structure and how they function. Similarly, a reactive hydrazide group is very different in structure and function from a reactive thiol group.

**3)** Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter requiring divergent fields of search and divergent patentability considerations, restriction for examination purposes as indicated is proper.

**4)** Applicants are advised that the reply to this requirement to be complete must include an election of the invention (***see the "Note" above***) to be examined even though the requirement be traversed (37 CFR 1.143).

**5)** Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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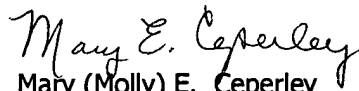
6) Applicants are advised that in accordance with the court decisions in *In re Ochiai*, {71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995)} and *In re Brouwer* {77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996)}, in the event that a product claim is found to be allowable, a method of use claim ***which is of the same scope as the allowed product claim*** may be rejoined with the allowed product claim.

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 27, 2006

  
Mary (Molly) E. Ceperley  
Primary Examiner  
Art Unit 1641